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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/373,984	08/16/1999	XING SU	70862/93137	3179

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EXAMINER

TUNG, JOYCE

ART UNIT PAPER NUMBER

1637

DATE MAILED: 09/16/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.
09/373,984

Applicant(s)

Su et al.

Examiner

Joyce Tung

Art Unit

1637



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jun 29, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: please see the attached.

3. ☐ Applicant's reply has overcome the following rejection(s):

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
please the attached

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: claims 1, 3-13, and 20-26

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

10. ☐ Other:

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The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1637.

1. The newly added languages “a population of different types of nucleic acids”, “forming a population of different types of at least two or more distinct species of DNA/RNA hybrids from a population of different types of different single-stranded mRNA species” and “forming a population of different types of single-stranded DNA from DNA/RNA hybrids” raise new issues that would require further consideration and/or search. Thus, the proposed amendment was not entered.
2. The newly added language “a population of different types...” is unclear how it is supported in the specification. Thus, the proposed amendment was not entered.
3. The rejection of non-statutory double patenting of claims 5-8 and 10-22 is maintained, because the terminal disclaimer has not been filed.
4. Claims 1, 3-7 and 22-26 remain rejected under 35 U.S.C. §102(b) over Sooknanan et al. (WO96/17079) based upon the language without entering the amendment filed 7/29/2002.

Applicants argue that the method of Sooknanan et al. is for amplifying a specific nucleic acid sequence and further requires the presence of a terminal repeat in the template, while the instant method is for the amplifying a nucleic acid population. However, it is unclear what is the differences between the specific nucleic acid in the presence of a terminal repeat and a population of nucleic acid.

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Applicants argue that Sooknanan et al. teach that the 5'-terminal sequence and the 3'-terminal sequence are self complementary. However, there is no description regarding this limitation.

Applicants argue that claim 26 describes thermo-stable enzyme but there is no limitation in the claim language on what is temperature range for the thermal stable polymerase.

Applicant's arguments filed 7/29/2002 have been fully considered but they are not persuasive. Therefore, the rejection is maintained.

5. Claims 8-13 remain rejected under 35 U.S.C. §103 (a) over Sooknanan et al. as applied to claims 1 and 3-7 of the instant claims and further in view of Kwoh et al. (Proc. Natl. Acad. Sci. USA, 1989, Vol. 86, pg. 1173-1177) and Goller et al. (Oncogene, 1998, Vol. 16, pg. 2945-2948).

As indicated in section 4 above, the consideration is based upon the claim language without entering the amendment filed 7/29/2002. The rejection is maintained with the same reasons as set forth in the Office action mailed 4/23/2002.

6. Claims 20-21 remain rejected 35 U.S.C. 103(a) as being unpatentable over Sooknanan et al. (WO 96/17079) as applied to claims 1 and 3-7 above, and further in view of Schnipelsky et al. (5,229,297).

As indicated in section 4 above, the consideration is based upon the claim language without entering the amendment filed 7/29/2002. The rejection is maintained with the same reasons as set forth in the Office action mailed 4/23/2002.

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7. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (703) 308-1119 on Monday-Friday from 10:00 AM-6:00 PM.

Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

8. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1637 via the PTO Fax Center located in Crystal Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung

September 10, 2002


GARY BENZION, PH.D.
SUPERVISORY/PATENT EXAMINER
TECHNOLOGY CENTER 1600